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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/542,323	07/13/2005	Frederic Demarne	1759.204	8915
23405	7590	08/10/2006	EXAMINER	
HESLIN ROTHENBERG FARLEY & MESITI PC 5 COLUMBIA CIRCLE ALBANY, NY 12203			MCCORMICK, MELENIE LEE	
			ART UNIT	PAPER NUMBER
			1655	

DATE MAILED: 08/10/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	10/542,323	DEMARNE ET AL.
	<b>Examiner</b>	<b>Art Unit</b>
	Melenie McCormick	1655

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on \_\_\_\_\_.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-21 is/are pending in the application.
  - 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-21 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.
 

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All    b) Some \* c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date <u>07/05</u> .	6) <input type="checkbox"/> Other: _____.

**DETAILED ACTION**

Claims 1-21 are presented for examination on the merits.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 4, and 12-14, and 17 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

A broad range or limitation together with a narrow range or limitation that falls within the broad range or limitation (in the same claim) is considered indefinite, since the resulting claim does not clearly set forth the metes and bounds of the patent protection desired. See MPEP § 2173.05(c). Note the explanation given by the Board of Patent Appeals and Interferences in *Ex parte Wu*, 10 USPQ2d 2031, 2033 (Bd. Pat. App. & Inter. 1989), as to where broad language is followed by "such as" and then narrow language. The Board stated that this can render a claim indefinite by raising a question or doubt as to whether the feature introduced by such language is (a) merely exemplary of the remainder of the claim, and therefore not required, or (b) a required feature of the claims. Note also, for example, the decisions of *Ex parte Steigewald*, 131 USPQ 74 (Bd. App. 1961); *Ex parte Hall*, 83 USPQ 38 (Bd. App. 1948); and *Ex parte Hasche*, 86 USPQ 481 (Bd. App. 1949). In the present instance, claim 4 recites the broad recitation between 3°C and 100°C, and the claim also recites

preferably between 20°C and 60°C, which is the narrower statement of the range/limitation.

Claims 12-14 are rendered vague and indefinite because it is not clear if the method as claimed is intended for in vivo or in vitro use.

Claim 17 recites the limitation "the complexion's" in line 2. There is insufficient antecedent basis for this limitation in the claim.

#### ***Claim Rejections - 35 USC § 102/103***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-11 and 15 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Sanou et al. (US 5874,401).

The claims are drawn to an extract of *Cryptomeria japonica*.

Sanou et al. disclose a an extract (pollen) which appears to be identical to the presently claimed extract composition, since it was extracted via the same essential steps as instantly claimed - i.e., first performing an aqueous extraction of a flower (which reads on the bud instantly claimed) of *Cryptomeria japonica*, then performing a solid/liquid separation step (centrifugation), and then a liquid phase retrieval step (a second centrifugation) (see e.g. col 3, lines 34-47). Consequently, the claimed *Cryptomeria japonica* extract composition appears to be anticipated by the reference.

In the alternative, even if the claimed extract composition is not identical to the referenced extract composition with regard to some unidentified characteristics, the differences between that which is disclosed and that which is claimed are considered to be so slight that the referenced extract composition is likely to inherently possess the same characteristics of the claimed extract composition particularly in view of the similar characteristics which they have been shown to share. Thus, the claimed extract composition would have been obvious to those of ordinary skill in the art within the meaning of USC 103.

Accordingly, the claimed invention as a whole was at least *prima facie* obvious, if not anticipated by the reference, especially in the absence of sufficient, clear, and convincing evidence to the contrary.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to

be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sanou et al. (US 5874,401) in view of Matsuhashi et al. (US 5,073,628).

An extract of *Cryptomeria japonica* D. Don buds is claimed.

Sanou et al. beneficially teach an extract of the flower of *Cryptomeria japonica* and is relied upon for the reasons set forth above. Sanou et al. beneficially teach that the extract of *Cryptomeria japonica* was extracted by first performing an aqueous extraction of a flower (which reads on the bud instantly claimed) of *Cryptomeria japonica*, then performing a solid/liquid separation step (centrifugation), and then a liquid phase retrieval step (a second centrifugation) (see e.g. col 3, lines 34-47). The extract beneficially taught by Sanou et al. reads on the extract instantly claimed. It is expected that the characteristics of the extract beneficially taught by Sanou et al. would be the same as those of the instantly claimed extract, since it was extracted using the same basic process as instantly claimed. It is further beneficially taught by Sanou et al. that the extract may be supplied in the form of an ointment (see e.g. col 15, lines 30-35) and that the composition may be administered permucosally, in which case the composition would intrinsically be applied to epidermal cells (see e.g. col 16, line 17).

Matsuhashi et al. beneficially teach a cream or lotion which contains a cedar pollen allergen (see e.g. claim 25) and may be administered percutaneously (see e.g. col 4, lines 23-30). The cedar pollen allergen beneficially taught by Matsuhashi et al. was obtained by the extraction of Omote

Sugi (*Cryptomeria japonica*), and would have intrinsically come from the flower of the plant.

It would have been obvious to one of ordinary skill in the art at the time the claimed invention was made to make an extract from the flower (bud) of *Cryptomeria japonica* in the manner beneficially taught by Sanou et al. and supply the extract in the form of a cream or lotion for application to the skin as beneficially taught by Matsuhashi et al. One of ordinary skill in the art would have been motivated to do so based upon the beneficial teachings of Sanou et al., which disclose that the *Cryptomeria japonica* extract composition may be in the form of an ointment (see e.g. col 15, lines 30-35). Stimulation (or cryoprotection or normalizing or moisturizing) of the dermal cells would intrinsically occur upon the inevitable application to the skin of such a composition. The adjustment of particular conventional working conditions (e.g. the particular dry matter content of the extract or the particular percent by weight of the extract within the composition) is deemed merely a matter of judicious selection and routine optimization which is well within the purview of the skilled artisan.

From the teachings of the references, it is apparent that one of ordinary skill in the art would have had a reasonable expectation of success in producing the claimed invention. Therefore, the invention as a whole was *prima facie* obvious to one of ordinary skill in the art at the time the invention was made, as evidenced by the references, especially in the absence of evidence to the contrary.

***Conclusion***

No claim is allowed.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Melenie McCormick whose telephone number is (571) 272-8037. The examiner can normally be reached on M-F 7:30am-4:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terry McKelvey can be reached on (571) 272-0775. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



CHRISTOPHER R. TATE  
PRIMARY EXAMINER